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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,169	01/12/2001	Ursula Murschall	00/002 MFE	2792
7590	12/01/2003		EXAMINER	
ProPat, L.L.C. 2912 Crosby Road Charlotte, NC 28211			UHLIR, NIKOLAS J	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb 19

Office Action Summary

Application No.

09/760,169

Applicant(s)

MURSCHALL ET AL.

Examiner

Nikolas J. Uhler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. This office action is in response to the amendment/arguments dated 8/27/03 (paper #15) and 9/26/03 (paper #18). Currently, claims 1-11 are pending. The applicant's amendment to claims 1 and 11 are sufficient to overcome the prior 35 U.S.C. 112 2nd paragraph rejections. Accordingly, these rejections are withdrawn. Further, the amendment to claim 1 is sufficient to overcome the prior objection to this claim.

Specification

2. The use of the trademarks "Hazeguard plus," and "Sylobloc," have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

3. Claims 1-2, 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall et al. (DE19630599) in view of Oishi et al. (US5936048).

4. This rejection is maintained as set forth in paper #16

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall modified by Oishi as applied to claim 1 above, and further in view of Rakos et al. (US6251505).

6. This rejection is maintained as set forth in paper #16

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7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall as modified by Oishi as applied to claim 1 above, and further in view of Schreck et al. (US5866246) and Kishida et al. (US5008313).

8. This rejection is maintained as set forth in paper #16

9. Claims 1, 7, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall as applied to claim 1 above, and further in view of Schreck et al., Kishida et al. and Ragan et al. (US4551485).

10. This rejection is maintained as set forth in paper #16

Response to Arguments

11. Applicant's arguments filed 9/24/03 have been fully considered but they are not persuasive. In the instant case, the applicant has presented two primary arguments. First, the applicant asserts that the Murschall reference applied by the examiner is an un-oriented film and thus not applicable to the instant claims, which require an oriented film. Second, the applicant asserts that the properties obtained by the invention are unexpected improvements over the prior art.

12. These arguments are not persuasive. With respect to the applicants arguments that the Murchall reference teaches that the film is un-oriented, the examiner agrees that Murschall in fact does state that the film is in an unoriented state, as shown at page 4, lines 35-41. However, the examiner notes that the Murchall reference utilizes an extrusion process to produce the film. Extrusion is known to cause orientation (albeit generally minor) in the machine direction. This is evidenced by column 1, lines 35-40 of US Patent #4784594 to Sharps. While the examiner understands from the specification

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that the applicant orients the instant film via heating and stretching the film after it is extruded, the claims are not limited to such orientation. The examiner respectfully reminds the applicant that while it is the examiners duty to read the claims in light of the specification, limitations from the specification are not read into the claims.

13. Regarding the applicant's argument relating to "unexpected results." The examiner acknowledges applicants attempt to establish the "unexpected" results of the instant invention over the prior art. However, the applicant's argument of unexpected results is unpersuasive, as: 1) the applicant has provided no data that compares the closest prior art to the instant invention; and 2) the argument of unexpected results is not commensurate in scope with the claims. The applicant in the arguments asserts that typically, polyesters yellow as a result of repeatedly heating and cooling the polymer during extrusion, orientation, heat setting etc... The instant claims require no heating steps, and indeed require no particular method of orientation. Further, applicants argue that the Murschall reference does not teach a film containing phosphorous based flame retardants or any other material based on flame retardants. While the examiner acknowledges that Murschall doesn't teach the use of flame retardants, particularly phosphorous based flame retardants, this deficiency is clearly addressed by the secondary references. Further, the last paragraph on page 9 of the instant specification states that only organic phosphorous flame retardants that are soluble in the thermoplastic are listed as suitable flame retardants that allow the optical properties of the invention to be obtained. The claims are not limited to these types of flame retardants. Absent a clear showing (i.e. data) that establishes the unexpected

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improvements of the instant invention over the prior art, and because the claims are not commensurate in scope with the showing of unexpected results, applicant's showing is deemed unpersuasive.

14. Applicants have additionally argued that the incorporation of a flame retardant into a polyester results in the yellowing of the film, and thus the combination of Murschall with Oishi would likely not meet the applicants claim requirements. However, the applicant's film in itself is capable of being yellow (i.e. it can have a yellowness of 9.9999...). Further, the applicant has not provided any data which conclusively shows that the addition of a flame retardant yellows the polymer to such a degree that it cannot meet the instant claims.

15. Finally, applicants have argued that the Murschall reference only teaches the formation of PET plates which are 0.8-20mm. The examiner respectfully disagrees. The applicant is directed to example 1 on page 7 of Murschall, wherein a trilayer film having an ABA structure is disclosed. The A layers are Polyethylene terephthalate that has been coextruded with the B layers. Specifically, the A layers are 0.25mm (250 μ) thick. Thus, the A layers of Murschall explicitly meet that applicants claimed thickness requirement.

16. All of the applicants remaining arguments hinge on those addressed above. Accordingly, the remaining arguments are also unpersuasive.

Examiner's Note

17. Without wishing to direct the applicant in any way, the examiner notes that the examiners argument as to the orientation of the film can be overcome by either

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specifying the method of orienting the film or requiring a degree of orientation (if supported in the specification). The examiner also acknowledges that the applicant may indeed have a product that shows unexpected improvements over the prior art.

However, without data comparing the instant invention to that of the prior art, the applicant's arguments give the examiner no basis by which to determine whether the results obtained by the instant invention are in fact "unexpected." The examiner notes that a clear comparison (including data) establishing the difference in optical properties between the instant inventions and that of the cited Murschall reference would be a very persuasive showing. Further, if applicant could provide data which establishes the criticality of the method of manufacture (i.e. films made by masterbatch technology can exhibit the claimed properties, while those made by other processes cannot) would also help to establish an argument of unexpected results.

18. Finally, the examiner notes that the applicant amended the instant claims to recite the standardized methods that the applicant utilized to obtain the claimed transmittance, gloss, and haze values. The examiner respectfully requests the applicant consider making the same type of amendment to insert the standardized method that is utilized to obtain the claimed yellowness value, as such an amendment would clarify the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 703-305-0179. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0389.

nju

nju

Paul Thibodeau

Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700